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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/775,712 | 02/09/2004 | Connie C. Liu | SEA-2845.1 | 3832 |

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EXAMINER

RICKMAN, HOLLY C

| | |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1773

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,712

Applicant(s)

LIU ET AL.

Examiner

Holly Rickman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 13 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/05 has been entered.

Election/Restrictions

2. Newly submitted claims 1-5, 13 and 15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: originally presented claims were directed to an information storage medium; claims 1-5, 13, and 15 are directed to a method which is patentably distinct from the originally presented article claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-5, 13 and 15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is rendered indefinite by the phrase “eliminating a subsequent polishing step.” The use of the term “eliminating” suggests that a polishing step must have been present in the first place in order to eliminate it. However, claim 16 does not state that a subsequent polishing step is present prior to depositing a magnetic recording layer. In fact, claim 16 states that the composite nickel coating is formed “without polishing.” Thus, it is unclear to the examiner how claim 17 further limits claim 16. Clarification is required.

Claim Rejections - 35 USC § 103

5. The rejection of claims 1-5 and 13 under 35 U.S.C. 103(a) as being unpatentable over Ross et al. (US 5980997) in view of Sato et al. (US 6699601) is withdrawn in view of the amendments to the claims. It is noted that claims 1-5 and 13 are now directed to a non-elected invention.

6. The rejection of claims 7-11 and 14 under 35 U.S.C. 103(a) as being unpatentable over Ross et al. (US 5980997) is withdrawn in view of Applicant’s cancellation of the claims.

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7. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al. (US 5980997).

Ross et al. disclose a magnetic recording disk having a substrate with a sputtered layer of NiP and an electrolessly deposited layer of NiP thereon (see col. 2, lines 18-50; col. 5, lines 7-10; col. 7, lines 7-11).

With respect to the claimed surface roughness(Ra) range, Ross et al. teach that it is preferred in their invention to provide a NiP surface that is smooth. While the reference is silent with respect to the specific values of Ra that correspond to this above mentioned disclosure, it is the Examiner's position that the reference is suggestive of a range of Ra that is as low as 0Δ . The reference teaches the preferred use of a smooth surface (i.e., this would ideally be 0Δ). Thus, it would have been a matter of routine experimentation for one of ordinary skill in the art to adjust the Ra of the NiP surface taught by Ross et al. to meet the disclosed surface requirements.

With respect to the limitations "as deposited" and "formed without polishing" (see claim 16) and "eliminating a subsequent polishing step" (claim 17), the examiner takes the position that these are process limitations in an article claim. Because the product taught by the prior art appears to be the same as the claimed product, these limitations do not patentably distinguish the present claims over what is known in the art. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

8. Applicant's arguments filed 6/24/05 have been fully considered but they are not persuasive.

Applicant's arguments are directed to process limitations in article claims. In the absence of evidence establishing that the claimed process steps result in a product that is patentably distinct from that shown in the prior art, the rejection of the claims under 103, as set forth above, is deemed proper.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'H. Rickman', with a stylized flourish at the end.

Holly Rickman
Primary Examiner
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